

REMARKS

The Examiner has rejected Claims 1-11, all claims of the application, under 35 USC 103 as unpatentable over the admitted prior art. The admitted prior art is that there are standard plastic grocery sacks in widespread use and there are standard paper grocery sacks in widespread use. In order to be strong enough to satisfactorily hold groceries, 1/6-barrel standard paper grocery sacks are made of 70-75 lb. paper and 1/8-barrel standard paper grocery sacks are made of 57 lb. paper. Further the height of the standard paper grocery sacks are greater than the height to the collar of open standard plastic grocery sacks. Generally, either standard paper grocery sacks are used or standard plastic grocery sacks are used. The admitted prior art relied on by the Examiner is that there is a trend in supermarkets for consumers to request that a standard paper grocery sack be placed as a liner in a standard plastic grocery sack. This gives the advantage of the handles for easier carrying of the standard plastic sack with the structural rigidity of the standard paper sacks, i.e., the standard paper sacks will stand up on a surface such as in a car or on a kitchen counter. However, it is pointed out that the greater height of the standard paper grocery sacks in relation to the standard plastic grocery sacks tends to interfere with the handles of the standard plastic sacks and makes the handles harder to use. A concern of supermarkets is that the standard paper sacks are very expensive, about three times as expensive as the standard plastic

sacks. Thus, the admitted prior art is that some consumers ask for standard paper grocery sacks to be placed in standard plastic grocery sacks, thereby using the standard paper grocery sacks as liners for the standard plastic grocery sacks. However, in that instance, the standard plastic grocery sack is merely acting as a holder or carrier for the standard paper grocery sack. Each sack is working separately. The standard paper grocery sack is carrying the groceries and the standard plastic grocery sack is carrying the paper sack.

There is no suggestion in the admitted prior art that anything other than standard paper grocery sacks be placed in standard plastic grocery sacks. There is no suggestion in the admitted prior art that a special paper liner be made for use as a liner of standard plastic grocery sacks, or as to how a special liner might be different than the standard paper grocery sack. There is no suggestion that anything other than the standard paper grocery sack be used as the liner or that there would be any desire by anyone to have anything other than the standard paper grocery sack as a liner if a liner is to be used. With a standard paper grocery sack, the sack can be used alone as a paper grocery sack or can be used in combination with a standard plastic grocery sack as a liner if specifically requested by the consumer. There is no suggestion that a paper liner be developed that specifically works with and supplements a standard plastic grocery sack in a synergistic way to allow the advantages of a standard plastic grocery sack to be used and also obtain the

benefits of a standard paper grocery sack, but at a reduced expense to the supermarket.

A significant part of applicant's invention is the realization that there might be an advantage to having a special paper liner for standard plastic grocery sacks even though this liner might not be usable as a grocery sack on its own if the consumer only wanted a paper grocery sack. In addition, an important aspect of the invention is the discovery, once it is realized, that special paper liners for standard plastic grocery sacks might be advantageous, that the advantages of a standard paper grocery sack as a liner are maintained with a lighter weight of paper than normally used in standard paper grocery sacks (cannot be used alone as a grocery sack), that this lighter weight paper has its own advantages (less cost), and that a shorter sack (less capacity than a normal paper grocery sack) is acceptable and works well to provide full use of the handles provided on the plastic sack. Further, if the base perimeter of the paper liner is approximately equal to the perimeter of the standard plastic grocery sack with which it is used as a liner, the shorter height still allows use of the full capacity of the standard plastic grocery sack; i.e., even though the PIPsack® has less capacity than a normal paper grocery sack, the PIPsack® uses the capacity of the plastic grocery bag more efficiently.

Applicant's invention, in line with those realizations, provides a light weight paper liner, a liner made of a lighter weight paper than would be used for a standard paper grocery sack

and that could not be used alone as a grocery sack, and a liner having a height shorter than the standard paper grocery sack so that the liner fits into the standard plastic grocery sack and the handles of the standard plastic grocery sack can be easily used without interference from the paper liner. To make the lighter paper liner work efficiently, the liner preferably has a base perimeter approximately equal to the base perimeter of the standard plastic grocery sack with which it is used so as to use the full carrying capacity of the standard plastic grocery sack. When a paper liner is placed in the standard plastic grocery sack, the standard plastic grocery sack tends to conform to the paper liner to surround and reinforce the lighter weight paper that is used, thus allowing use of the lighter weight paper and the resultant cost savings in paper. There is absolutely no suggestion in the admitted prior art or other prior art that such a paper liner can be successfully used as a liner for a standard plastic grocery sack.

The Examiner states, Page 2 of Final Action, that while a "paper liner whose base and height are 'approximately equal' to that of an expanded 'standard plastic grocery bag' are not found" in the prior art, "it would have been an obvious matter of design choice to make the admitted prior art paper liner with base and height dimensions that are approximately equal to a standard plastic grocery bag." The Examiner says that "such a modification would involve a mere change in size of a component", and cites In re Rose as holding that "a change in size is

generally recognized as being within the level of ordinary skill in the art." However, In re Rose involved making a package of an otherwise obvious arrangement of lumber into a package of appreciable size and weight so as to require handling by a lift truck whereas the prior art showed similar packages that could be lifted by hand. There the court found that the difference was an obvious change in size. It was merely increasing the size of a package as shown in the prior art. Further, it was an increase in the overall size of the package of lumber. It was not a change in the size of a component of the package that changed the resulting package. Here the inventor is not merely changing the size of the resulting plastic grocery sack. The inventor is changing the size of the liner so that it can be used in conjunction with the standard plastic grocery sack to produce a new result. In re Rose did not show a larger package that produced a different result, nor did it show changing the size of one component of the overall package to produced a different result. The different result in Rose was merely the larger package. Here, the change in size of the liner allows it to be used as a liner much more effectively than the prior art grocery bag used as a liner. There is no suggestion in the prior art that the change in size of one component, the liner, could increase the effectiveness of the total combination, the plastic bag with liner.

The Examiner states in the last paragraph on page 2 of the Final Action that "[t]here is nothing [in] applicant's disclosure

that would indicate the increased paper liner capacity and reduction in paper liner material, . . . , is an unexpected and superior result" Applicant disagrees. Applicant points out the superior results in several places in the application. For example, the objects of the invention are to "make more efficient use of paper by providing a paper liner that would conform more closely in shape and size to the plastic sack" and "to use less paper by providing a paper liner that would be made of lighter weight paper". On page 13, the applicant states the advantages of his liner and that the advantages are obtained by minimizing the paper used and the cost of the liner. Certainly superior results are pointed out. Applicant also states on Page 13 that "the invention involves the realization that the advantages of both plastic and paper sacks can be achieved by the use of a light weight paper liner in the plastic sack". This certainly at least intimates the unexpected nature of the results. Further, the explanation of the invention as an invention intimates the unexpected nature of the results. It is not the usual practice, although it is sometimes stated, for the inventor in the specification to make the self-serving statement that the invention produces "unexpected" results. Merely stating that the invention produces the advantages of both the plastic and paper sacks while using less paper shows both superior results and the unexpected nature of the result. It should be pointed out, that applicant provides training and educational materials for new supermarket customers to educate both

management and employees in the features and benefits of the use of PIPsacks®. If applicant's invention were obvious, it would not be necessary to provide training and educational material to supermarket management and employees.

The Examiner states in the second paragraph on page 3 of the Final Action: "It would have been obvious . . . to use a grade of paper between 35 lbs. and 50 lbs. . . . since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice." The statement requires that, to be obvious, the suitability for the specific use must be known. Here, the use is a sack made of paper to be used as a liner for a standard plastic grocery sack. The prior art used standard paper grocery sacks as liners. This teaches use of the same weight paper as the standard paper grocery sacks. Thus, before a lighter weight paper than that being used in the prior art would be selected by a worker in the art as suitable for the intended use, it would have been known that lighter weight paper would be suitable for and could be used for the intended use. Here, there is absolutely nothing in the prior art to indicate or suggest that the lighter weight paper would be satisfactory for such use. It is only by use of impermissible hindsight based on applicant's teaching that the lighter weight paper can be used satisfactorily, that a worker in the art would know that a lighter weight paper would be suitable for the use and would therefore be selected by such worker. The Examiner

cites In re Leshin as supporting his rejection. However, In re Leshin dealt with an assertion that making a cosmetic holder out of plastic generally when the prior art showed similar cosmetic cases made of plastic, was unobvious. It does not appear from the decision in that case that the claims recited a particular plastic or any particular properties of the plastic. It did not claim a lighter weight plastic than used in the prior art. No arguments were made that a particular plastic was recited and was unobvious. Here, "paper of a lighter weight than that used for standard grocery sacks" is recited. Further, the particular paper weight of between 35 and 50 pounds is recited in Claims 7 and 13 while the prior art uses paper of weight between 57 and 75 pounds. It is this difference that is not shown or suggested as suitable by the prior art that applicant asserts is unobvious, not merely that the liner is made of paper.

The use of a standard paper sack as a paper liner having a height approximately equal to the height to the collar of any standard plastic grocery sack is nowhere shown in the prior art. The use of a lighter weight paper than used for a standard paper grocery sack is nowhere shown in the prior art. It is not obvious to use a paper liner, having a grade of paper between 35 lbs. and 50 lbs. and having a height approximately equal to the height to the collar of a standard plastic grocery sack. In fact, the use a paper liner, having a grade of paper between 35 lbs. and 50 lbs. and having a height approximately equal to the height to the collar of a standard plastic grocery sack is

synergistic in effect: 1) The height of the paper liner does not interfere with the handles of the plastic bag and therefore the combination is easier to carry, and 2) the lighter weight paper makes for more efficient use of paper without reducing its useful effect of having a combination carrier whose structural rigidity enables such combination to stand up when set down on a surface such as in a vehicle. In addition, when such lighter weight paper liner is fit into the plastic sack, particularly when the base perimeter of the lighter weight paper liner is approximately equal to the base perimeter of the standard plastic grocery sack, the liner significantly synergistically adds burst-and-tear-resistance strength to the plastic sack while the plastic sack synergistically adds support and strength to the lighter weight paper used for the liner. Even though the 1/8-barrel sack and the PIPsack are the same height, the PIPsack more effectively fills the space inside a standard plastic sack. The fact that the PIPsack® is able to command a higher price per ton of paper than the typical 1/8-barrel sack (see, Applicant's Second Declaration, ¶ 9) shows that supermarkets and their customers prefer the PIPsack as a liner just because of the synergistic interaction of the height of the paper liner not interfering with the handles of the plastic bag and the lighter weight paper makes for more efficient use of paper. This indeed is further evidence of unexpected results of the use of PIPsack® as a paper liner.

With regard to the Examiner's remarks beginning at the second paragraph of page 4, applicant submits a Second

Declaration herewith to clarify certain points raised by the Examiner. Applicant's Second Declaration sets forth the details of the liner sold to show that it is the liner of the invention and falls within the claims of the application. The liner sold, being of lighter weight paper than normal paper grocery sacks, can only satisfactorily be used as a liner for plastic grocery sacks. While there has been limited advertising for the liners; there have been no sales promotions; there have been no discounts; and there have been no introductory offers! While initial sales may have resulted through contacts applicant has in the supermarket industry in the Pennsylvania-New Jersey-Metropolitan New York area, the sales information presented shows that the sacks have been reordered and continue to be ordered and reordered and used by the supermarket customers. Further, new customers continue to be added over the time period, and the area of sales has expanded to include eastern Ohio, Delaware, and Maryland.

In the present case, because applicant has a small company and has only done advertising of the product in trade publications and has only attempted to sell the sack in a limited geographic area, commercial success is not indicated by large sales of the product, but is indicated by continuing orders and reorders of the product by supermarket customers once they have tried the product. Further, other customers and customers in the expanded area of sales have been added as customers. The direct customers for the product of the invention is the grocery store

and supermarket industry. However, the acceptance by the ultimate consumer of the grocery store or supermarket is required for the grocery and supermarket industry to continue purchasing the product.

The PIPsack® being made of lighter weight paper has less tear-and burst-resistance strength than that of standard paper grocery sacks. Therefore, since the product should be used as a liner for plastic grocery sacks and not as a stand alone paper sack, the continued use and reordering of the product is an indication of acceptance and use of the product based upon the claimed features of the product. There would be no other reason for a supermarket to reorder the product unless it was being used and unless it was accepted for use on the basis of the inventive and claimed features. There would be no reason to continue to use the product if it did not have advantages over the use of standard paper grocery sacks as liners. Even if the advantage to the supermarket industry of the invention is a reduction in cost of the product compared to standard paper grocery sacks, this reduction in cost is a direct result of the claimed features of the invention, i.e., the uses of lighter weight paper and a reduced height which result in reduction in paper used and reduction in paper cost.

With regard to the Examiner's statements regarding the lack of showing market share or the time period during which the product was sold, applicant points out that his original Declaration did set forth the time period over which the sales

indicated were made. The Declaration was very specific and set forth sales by month from first sales in October 2000 through sales in May 2002. Since this is a completely new product, and is used only when requested by a customer of the supermarket, there is no basis for being able to determine what sales would normally be for such a product. Further, for the same reason, there is no basis to determine or state a market share. Since the product is new and unique, it could be said that applicant has 100% of the market share. Since the product is not a substitute for regular paper grocery sacks, it would mean nothing to try to state sales as a share of the market for standard paper grocery sacks. The number of standard paper grocery sacks sold, as indicated by applicant's Second Declaration, is not known by applicant. Production and sales of paper are always reported as tonnage of kraft paper. For people who report sales or production of paper, i.e., supermarket industry, fast food industry, retail sales, and the food service industry, sales and production are not broken down into specific categories or specific markets. Further, individual sales are closely guarded information that no one will release. However, to be meaningful at all, a total market number would have to be broken down into the number of those standard paper grocery sacks used as liners for plastic grocery sacks rather than used alone as intended as paper grocery sacks.

The cases cited by the Examiner are fact specific and make general statements as to no showing of market share or no showing

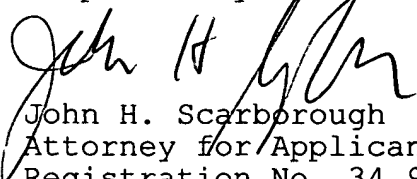
of time period over which sales were made. As indicated, the time period over which sales have been made is specifically set forth in the applicant's original Declaration. Nothing in the cited cases indicate that a showing of market share is a requirement to show commercial success. The Court in Cable Electric Products, Inc. v. Genmark, Inc. cited by the Examiner merely says that whether "the reported sales represent a substantial share of any definable market or whether the profitability per unit is anything out of the ordinary in the industry involved" are examples of information that "might bolster the fact of any commercial success which may be demonstrated by the" declaration. However, it depends on the facts shown as to whether such facts indicate commercial success and whether that commercial success is "shown to have in some way been due to the nature of the claimed invention." Here, the fact shown by applicant's Declaration that significant sales have been made and continue to be made in the limited geographical market in which applicant has attempted to sell is the important indicator of commercial success. This is not a product that supermarkets are going to use on a universal basis. In other words, a supermarket is not going to start placing paper liners in all standard grocery sacks because, if a customer is satisfied to use only the standard plastic grocery sack, the supermarket is not going to incur the additional expense to add the liner. Further, in accordance with prior art practice and customer desires, if a customer requests a paper grocery sack, the

supermarket will provide the standard paper grocery sack, as requested, without the plastic sack. It is only in the situation where the customer requests a paper sack in a plastic sack that the liner of the invention will be used. No effort has yet been made to replace the standard paper grocery sack with a standard plastic grocery sack and paper liner. This would probably be the next step in promoting the invention. Thus, use of the invention for its purpose as a liner for standard plastic grocery sacks when a liner is desired by and asked for by the customer is an indication of commercial success of the invention, and is an indicator of nonobviousness of the invention.

Neither the use of lighter weight paper nor the reduced height of the liner is suggested by the admitted prior art, nor is the combination of the two suggested. Applicant submits that none of the pending claims are made obvious by the cited art and that such claims should be allowable. Further, if the Examiner is not convinced of the unobviousness of the invention based just on the arguments presented regarding the cited prior art, applicant submits that a sufficient showing of commercial success has been made to indicate unobviousness and that the claims should be allowed.

Favorable reconsideration is respectfully requested.

Respectfully submitted,


John H. Scarborough
Attorney for Applicant
Registration No. 34,921
428 Fireside Lane

Cherry Hill, NJ 08003

February 25, 2003
Cherry Hill, New Jersey

THIS PAGE BLANK (USPTO)

Version Of Claims With Markings To Show Changes Made

2. (Amended) A paper liner for plastic grocery sacks, [according to Claim 1, wherein the] comprising:

a paper container [is] made of a grade of paper of lighter weight than that used for standard paper grocery sacks of similar base perimeter; and having

a base whose perimeter is approximately equal to the base perimeter of standard plastic grocery sacks; and

a height approximately equal to the height to the collar of standard plastic grocery sacks when said standard plastic grocery sacks are opened and expanded.

3. (Amended) A paper liner for plastic grocery sacks, according to Claim [1] 2, wherein the base has dimensions of 12 inches by 7 inches and the height is 12.5 inches.

4. (Amended) A paper liner for plastic grocery sacks, according to Claim [1] 2, wherein the base has dimensions of 12 inches by 7 inches and the height is 10.5 inches.

5. (Amended) A paper liner for plastic grocery sacks, according to Claim [1] 2, wherein the base has dimensions of 11.5 inches by 6.5 inches and the height is 12.5 inches.

6. (Amended) A paper liner for plastic grocery sacks, according to Claim [1] 2, wherein the base has dimensions of 13 inches by 8 inches and the height is 13 inches.

10. (Amended) A paper liner for plastic grocery sacks, according to Claim [8] 2, wherein the base has dimensions of 12 inches by 7 inches and the height is 14 inches.

11. (Amended) A combination of a paper liner and a standard plastic grocery sack, comprising:

a standard plastic grocery sack; and

a paper [container] liner having a base whose perimeter is approximately equal to the perimeter of the standard plastic grocery sack [positioned] within which the [plastic grocery sack] liner is positioned;

a height approximately equal to the height to the collar of the standard plastic grocery sack within which the liner is positioned when the standard plastic sack is opened and expanded; and

said paper [container] liner is made of a grade of paper lighter in weight than that used for standard paper grocery sacks of similar base perimeter.